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APPLICATION NO.	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09-912,414	07-26-2001	Rolf Muller	620-151	4579

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NIXON & VANDERHYE P.C.  
8th Floor  
1100 North Glebe Rd.  
Arlington, VA 22201-4714

[REDACTED] EXAMINER

MCKELVEY, TERRY ALAN

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1636

/S

DATE MAILED: 02-25-2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/912,414	MULLER ET AL.
	<b>Examiner</b> Terry A. McKelvey	<b>Art Unit</b> 1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 December 2002.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) 26 and 27 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-19,22 and 23 is/are rejected.
- 7) Claim(s) 20,21,24 and 25 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 19 November 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.  
4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group I, claims 14-25 in Paper No. 14, filed 12/3/02 is acknowledged. The restriction to one particular sequence from the three recited in the claims is rescinded for the instant claims because the examiner was able to convince the library to search all three sequences. No additional sequences will be searched in this application because of the search burden. The traversal is on the ground(s) that the claims of Group I drawn to having an activity is related to the process of Group II and thus there is no burden to examine them together. This is not found persuasive because the search for the peptides of Group I does not necessarily include the search for the method of Group II because "activity" is not the same as a process and "activity" is an inherent part of peptides of specific structures. Thus a search of Group I does not include all of what must be searched in Group II, including different patent searches because of different classification (which by itself is *prima facie* evidence of search burden to search together) and different non-patent literature searches due to search for method steps not present in the search of Group I.

The requirement is still deemed proper and is therefore made FINAL.

Claims 26-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 14.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14, 17-18, and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by JP06192290-A.

JP06192290-A teaches a 6 amino acid peptide consisting of WFFWFF (SEQ ID NO:9), and a composition comprising the peptide in association with a carrier (immobilized on the carrier) (abstract). See the attached sequence comparison. This peptide reads on a variant of SEQ ID NO:2 with three amino acid substitutions.

The instant application indicates that peptides of SEQ ID NO:9 are capable of binding to an E2F DNA binding site. Because JP06192290-A teaches a SEQ ID NO:9 peptide, it is encompassed by applicant's claimed peptide and thus it appears to inherently have the recited E2F binding activity even though that activity is not specifically indicated in the cited reference because activity is inherent to a peptide's structure, and not dependent on recognition of that activity. The degree of activity, such as in claim 18, is not indicated, but the peptide is substantially identical in structure to the peptides that do have the activity. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

***Claim Rejections - 35 USC § 101***

35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Claims 14-19 and 22-23 are rejected under 35 U.S.C. § 101 because the claimed invention is drawn to non-statutory subject matter.

The preamble of the claims recites "A polypeptide" or "The polypeptide". Polypeptides that are natural proteins or are naturally derived from natural proteins are products of nature that are not statutory subject matter because they fail to show the "hand of man" in their construction. Although the claimed polypeptides are shorter than the full length natural proteins that the polypeptides appear to be derived from, the truncation does not necessarily demonstrate the hand of man because truncated natural polypeptides occur naturally, such as during degradation of the full length polypeptide during normal metabolism of cells. Amending the claims to recite "An isolated polypeptide ..." (for the independent claim) would be remedial.

#### ***Double Patenting***

Claim 23 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 22. When two claims in an application are duplicates or else are so close in content that

they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k) .

Claim 23 is a duplicate of claim 22.

***Allowable Subject Matter***

Claims 20-21 and 24-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014.

NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's

representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached on (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**Terry A. McKelvey, Ph.D.  
Primary Examiner  
Art Unit 1636**

February 24, 2003